

IN THE  
UNITED STATES  
CIRCUIT COURT OF APPEALS  
FOR THE NINTH CIRCUIT

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LOUIE J. ANTONSEN,  
*Plaintiff-Appellant,*

VS.

C. C. HEDRICK, individually, and doing  
business under the assumed name and  
style of PAPER EXCELSIOR & PAD  
COMPANY,

*Defendant-Appellee.*

UPON APPEAL FROM THE DISTRICT COURT OF THE  
UNITED STATES FOR THE DISTRICT OF OREGON

---

REPLY BRIEF  
FOR PLAINTIFF-APPELLANT

---

**FILED**

OCT 15 1935

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**No. 8235**

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DEFENDENT'S BRIEF FURTHER LIMITS THE  
ISSUE TO THE SINGLE QUESTION OF  
WHETHER THE DEVICE OF CLAUDE C. RAFT-  
ER CONSTITUTED PRIOR USE OR ANTICIPA-  
TION OF PLAINTIFF'S PATENT

Defendant's brief limits the issue on this appeal to  
one question, namely, did the device of Claude C. Raft-  
er constitute prior use and anticipation of the mechan-  
ical means of Claims 1 and 2, and the method of Claim  
7 of Plaintiff Antonsen's patent No. 1,731,967.



The Trial Court's observation in his opinion, on page 30 of the Record, is instructive,

"Antonsen has been issued a patent by disclosure of the essential features made by him in the United States, February, 1925. This grant carries with it a strong presumption of validity in view of the fact that paper excelsior is a present commercial necessity, and of the fact that patentability of the device has been decided favorably by two other Federal Courts, there seems to be little ground for contention as to those features, but the chief defense in this case is lack of novelty . . . the burden of proof to establish lack of novelty lies upon the Defendant."

The Defendant likewise has admitted the commercial necessity of paper excelsior as a packing material. Indeed, that fact is obvious, because paper excelsior is used from coast to coast, and in the few years of its existence has almost entirely replaced wood excelsior for commercial packing purposes.

The cutting method, formerly employed in the prior art in manufacturing paper excelsior, was limited in capacity as to the number of sheets of paper that may be fed through the shredding head of the machine at one time. The cutting method caused so much difficulty for the operators of those machines by jamming, choking, and stopping the machine, that the tearing method, invented by Antonsen, was readily accepted by those engaged in the paper excelsior art throughout the country. The undisputed facts in the record show that the

tearing method, employed by the patent in suit, increases production capacity of excelsior cutting machines more than four times. (R. 77) It effects a saving of \$2.00 on every ton of excelsior manufactured. (R. 77)

The Defendant admits that he is now using the tearing method, and desires to continue to do so. In view of this, the Defendant is unable to dispute the utility of Plaintiff's patent.

Defendant rests his whole case upon the claim, that Claude C. Rafter's device for manufacturing paper excelsior anticipated Plaintiff's patent in suit. To determine whether Rafter's device was a CUTTING or TEARING machine, is to dispose of this suit! Defendant has set up the claim that it was a tearing machine. The burden of proof, therefore, is on him to establish that fact beyond a reasonable doubt. (See citations from the U. S. S. C. and 9 C. C. A. commencing on page 70 Plaintiff's opening brief)

Defendant MUST FAIL IN HIS CLAIM OF PRIOR USE because he cannot escape the effect of Rafter's patent application, Ex. 28. Rafter applied for a patent on a paper *cutting* machine in January, 1924 and prosecuted it until October, 1928. IT WAS FINALLY REJECTED AS LACKING INVENTION! If Rafter's device anticipated Plaintiff's patent, then Rafter would have received the patent, not Antonsen. They were both in the Patent Office and both being prosecuted at the same time. Antonsen was granted the patent in suit on the *tearing* method. Rafter was de-



nied a patent on the *cutting* method, because cutting was old in the art.

The rejected patent application of Rafter, is clearly the most vital exhibit in this entire case. It shows more clearly than any amount of oral testimony possibly could, just what kind of an excelsior machine Rafter had. None of Rafter's machines in their original condition are available for evidence.

Defendant admits that the mechanical means and method described in Rafter's patent application does not anticipate Antonsen's invention. Defendant seeks to avoid the disastrous effect of Rafter's application by claiming that it did not accurately portray the Rafter device.

The Record shows, however, that the application did describe Rafter's device accurately. In that connection, Rafter testified as follows:

R. 282 "I made a sketch of the machine in Jan. 1924.

R. 287 I have had 15 years mechanic's experience. I can read blue print drawings of machines. I can read detailed shop drawings.

R. 282 I took the sketch and a sample of the excelsior to my attorney.

I explained to him how the machine worked. He understood it." (Also see R. 311)

When the application and the patent drawings were prepared by Rafter's attorney, Rafter read them, signed them and swore to them.

Defendant contends, that because the attorney didn't see the machine itself, error crept into the application.

But, Rafter hired additional attorneys in 1927, to assist in the prosecution of the patent. (R 311) The additional attorneys did see the machine itself and the product. Notwithstanding, the prosecution continued on exactly the same mechanical means and cutting method. Final rejection was made in October 1928.

All suspicion of the two sets of patent attorneys misunderstanding Rafter should be removed by Rafter's testimony at the trial. In clear and unequivocal language, Rafter branded his device as a cutting one as follows:

R. 284 Q. Do you observe that spring there?

A. Yes, I put it there.

Q. What was the mechanical function of that spring?

A. Well, it was to keep the upper roll against the lower roll in contact, so it would draw the paper in.

This is exactly the wording of Rafter's patent application on page 1 (Ex. 28-, as follows:

"Another object of the invention is to provide knives for a paper cutting machine which may be arranged on two spindles so that their cutting edges may be positively held together at all times."

Similar wording appears thruout the entire file wrapper. If, as Defendant contends, Rafter's patent attor-

neys misunderstood him, it is indeed strange that Rafter should testify in Court, under oath, nearly ten years later, to exactly the same mechanical means! WITH THIS EVIDENCE IN THE RECORD THERE IS NO REASONABLE DOUBT BUT THAT RAFTER'S DEVICE WAS A CUTTING MACHINE.

Under date of March 1925, an article was published in the Sunday Times in the City of Seattle. A copy of that article was admitted in evidence as Ex. H. That article was the result of an interview with Rafter's son. The son at that time was working for Antonsen and operating one of Rafter's original devices. The son read the article and testified that it was exactly as he had told it to the reporter.

Throughout the article Rafter's machine is described as a cutting device, with a series of blades that act like the blades of shears. That article was published 14 months after Rafter's patent application. The news article, Rafter's patent application and Rafter's oral testimony corroborate each other. If the burden of proof were on the Plaintiff to prove Rafter's device were a cutting machine, the foregoing proof would be amply sufficient. BUT the burden is on the Defendant to prove beyond a reasonable doubt that Rafter's device was a tearing machine. With such physical exhibits as Ex. 28, Ex. 29 (Rafter's patent drawing) and Ex. H, the newspaper article in the record, can there be any doubt that Rafter's device was a cutting machine?

Ignoring all of the physical evidence just referred

to, (Ex. 28 Rafter's File Wrapper, Ex. 29 Enlarged drawing of Rafter's machine and Ex. H., Times Newspaper Article, and the enlargements of photos of piles of excelsior pictured in said Article) the Trial Court based his decision upon conflicting and contradictory oral testimony of the witnesses. Attorney for Defendant on pages 16 and 22 of his Answering Brief seeks to uphold the Trial Courts Decision.

In doing this, the Trial Court and Attorney for Defendant have placed themselves in an *untenable position*.

This Court's attention is respectfully directed to the bold faced type appearing on pages 16 and 22 of Defendant's brief, as follows:

Page 16

“REVIEW OF EVIDENCE SUPPORTING FINDING THAT RAFTER'S MACHINE WAS ADJUSTED SO THAT THE INTERMESHING DISCS WERE SEPARATED.”

Page 22

“REVIEW OF EVIDENCE SUPPORTING FINDING THAT IT WAS AN INHERENT INCIDENT AND QUALITY OF THE RAFTER MACHINE THAT UNDER LOAD A SEPARATION WOULD TAKE PLACE BETWEEN THE ADJACENT INTERMESHING DISCS.”



If Rafter's device is ADJUSTED so that the inter-meshing discs were separated, then obviously the discs would not be in facial contact and become SEPARATED UNDER LOAD. If the discs were adjusted out of contact, then a *separation would be constant at all times*.

While Plaintiff denies both of these propositions and contends that they are not supported by any competent evidence, we wish to point out that *if the evidence is insufficient* to enable the Trial Court to satisfy himself therefrom on the sole question in this case, namely, what was the actual adjustment of Rafter's machine, and if the Defendant is unwilling to rely and argue his case upon one adjustment or the other as the actual adjustment of that machine, THEN DEFENDANT HAS FAILED TO ESTABLISH ANTICIPATION by that degree of proof imposed upon him by law.

Surely, a patent regularly issued, with its strong presumption of validity cannot be voided and held for naught upon evidence which is insufficient to enable the Trial Court to definitely say what the actual adjustment of the anticipating device was.

In effect, is not the Findings of the Trial Court and the argument of counsel of the "shot gun type"? The theory is, that if one proposition is not sustained, then perhaps the other one will be.

A similar uncertainty in the Trial Court's findings and arguments of counsel is contained in the opinion on page 33 of the Record, where the Court said:

“Whether the Rafter machines were constructed according to design or not they were subject to deviation therefrom as a result of use. The dulling or chipping of the cutting edges of the disks, the weakening of the spring, or the shifting in alignment of the disks themselves due to a failure to keep the nuts tight, or due to the difference in the thickness of the washers between them alike would change the essential character of the operation and of the product”.

Apparently, The Trial Court was unable to find whether the Rafter machine was changed by *design*, or whether a change resulted from *wear*. From the evidence submitted, the trial Court was called upon, and did speculate that it could be one or the other, but he could not say which.

If the change was due to wear, the Court was called upon and did speculate whether that resulted from (a) weakening of the spring, (b) dulling or chipping of the discs, (c) shifting in alignment of the disks, (d) failure to keep the nuts tight, (e) difference in the thickness of the washers.

Again, Plaintiff points out that such evidence, if unable to convince the Trial Court of what the actual condition was, is not of sufficient weight to comply with the burden of proof the Defendant must bear.

Conceding for the sake of argument that the Rafter device was changed by wear from a cutting to a tearing machine WHEN DID THIS 'WORN OUT CONDITION OCCUR? To constitute prior use of Plaintiff's



patent, that condition must have occurred more than two years prior to Plaintiff's application. The application was in August, 1926; two years would take it back to August, 1924. The first operation of Rafter's device was around September, 1923. There is no evidence that the spring weakened over night, nor that the worn out conditions were evidenced over night, or at all. The original spring on the Defendant's machine placed there by Rafter is still functioning, and the original discs placed there by Rafter are still in operation. The only change in Defendant's machine is in the adjustment of the discs, which has been accomplished in that manner and method pointed out by Plaintiff's experts.

Another inconsistent position found in the Court's opinion is with reference to his statement on R. 31:

"The presumption is that Defendant's machine operates now as it did when first constructed."

If the Court was justified in this presumption, then the Court was clearly wrong in finding Rafter's device had changed from a cutting to a tearing machine by wearing out, by weakening of the spring, dulling and chipping of the discs, etc. In effect, the Court in one part of his opinion, points out that Defendant's machine has been changed by: (a) Design. (b) or wear, weakening of spring, chipping, dulling of discs, loosening of nuts, etc., and in another part of his opinion, the Court points out (c) that he is presuming that the Defendant's machine is unchanged. *This was clearly error.*

If Defendant's machine did come to function as a tearing machine by reason of wearing out THAT COULD NOT CONSTITUTE PRIOR USE. Such a condition would be so indefinite, improbable of reproduction, so uncertain, and so inaccurate that it would constitute no advancement in the art. *No patent could ever issue thereon.* Such a process could not possibly be understood nor appreciated. It would be wholly accidental, and any torn excelsior coming therefrom would be wholly incidental.

We set forth in our opening brief, starting on page 78, the leading cases upholding the well established doctrine that prior use must be understood and appreciated, and not something that is incidental and accidental. We here wish to call the Court's attention to *Chisholm et al. v. Randolph Canning Co.*, (C. C. Wisconsin) 135 F. 815, 816

"While it is true that the resemblance in the general form of the machines is striking, it is obvious from the descriptions given by Mme. Faure that she had no conception of the impact method which was discovered by the Chisholms."

*Beckwith v. Malleable Iron Range Company*, 175 F. 1001.

"The law is well settled that such prior accidental production when the character and function were not recognized until the patented invention came into being cannot be relied upon by way of anticipation."

“Looking backward several stove makers now see how nearly they approached the consummation finally reached by Beckwith, but none of them hit upon the coacting law by means of which these three elements were combined to produce new and practical results so long sought. Their unsuccessful efforts in the art cannot now defeat a patent founded upon a re-adjustment of materials by which new and useful results have been brought about.”

Ajax Metal Company v. Brady Brass Company, 155 F. 409.

“It is incumbent upon the Defendants therefor to show that prior use which is set up was so far appreciated at the time and adopted or followed, as to create a well understood, if not an established practice, capable at any time of being resorted to, and not something incidental, indefinite and fugitive, which is now hunted up and brought forward simply for the purpose of defeating the patent.”

There are numerous other cases affirming this long established rule of law.

Counsel has made some reference to the early relations of Antonsen to Mr. Rafter, and the fact that Mr. Antonsen purchased Rafter's machine and plant for \$2900.00.

As explained in our oral argument, Antonsen was informed by Rafter that he was getting patent protection. (R 82) To substantiate our claim in that regard,

we call the Court's attention to Plaintiff's Exhibit C, which is the original agreement between Mr. Rafter and witness Foster for the sale of a machine. In a portion of that agreement, Mr. Rafter recites that he has a *patent pending* upon the machine which he is selling. The facts are that Rafter did have a *patent application filed*. Mr. Rafter misrepresented when he stated he had a *patent pending*. The grossness of his misrepresentation fully appears from the record when the Patent Office rejected Mr. Rafter's patent application as lacking invention. However, *it was the patent protection that Mr. Antonsen thought he was buying*, and in our humble opinion fully explains the relations between Plaintiff and Mr. Rafter.

As further pointed out in our argument, Mr. Antonsen, after purchasing Rafter's machine, continued with the operation of it, but found the same difficulty that he had had with his own machines, namely, that the machine clogged, jammed and stopped when fed in excess of ten sheets. It was limited in capacity. Antonsen had large quantities of surplus paper coming to him from the over-issue newspapers. He continued experimenting with his own machine and finally discovered the tearing method. He applied for a patent. It was granted to him because it was an improvement over the prior art.

Rafter now seeks to obtain the benefit of Plaintiff's invention by claiming that he had the same process of manufacture in his early devices.

In that contention, Mr. Rafter is clearly refuted by



his own patent application, which is a silent, unprejudiced witness, whose testimony does not depend upon a failing and faulty memory, desire or friendship. Furthermore, Mr. Rafter's contentions are refuted by his own oral testimony given in open court as outlined hereinbefore when he said the intermeshing discs were in contact to draw the paper in.

In 1926, when Plaintiff applied for the patent in suit, he placed himself definitely on record about the advantages of his invention over the prior art, as follows: Exhibit 1, Record 71,

Line 5. "It has been customary heretofore to cut the paper into narrow strips or shreds by means of a machine consisting essentially of a pair of oppositely rotating, parallel shafts on which are mounted cutting disks intermeshed and in facial contact."

Line 20. "Machines of the type mentioned have a comparatively small production capacity because of the inherent limitations in the cutting process, and in the method used to feed the material to the cutters."

Line 25. "The object of my invention is to provide improved means for the shredding of paper whereby the same is torn, instead of cut, into narrow strips or shreds, producing thereby irregular feathery edges."

R. 72, Line 90, "This method of shredding has proved to be far superior to the cutting method for the manufacture of paper ex-

celsior, and the machine described embodying my invention has been found to have a production capacity many times that of other shredding machines of comparable size.”

The limited capacity of Rafter’s cutting device was definitely established by the testimony of many witnesses, set out in our opening brief, pages 49 to 53.

That part of the evidence, considered together with the facts contained in Exhibit 28, 29, H, and the enlarged photographs of excelsior, refutes completely Defendant’s claim that Rafter’s device was a tearing machine. It must be remembered that the burden of establishing Rafter’s device as a tearing machine at all times rests upon the Defendant. The reliable proof in this case, as outlined above, is diametrically opposed to Defendant’s claim of tearing. An examination of the record will bear out Plaintiff’s contention.

To overcome this damaging evidence, counsel for Defendant in his brief, starting on page 6, sets forth his conclusions of the oral testimony of early users of Rafter’s excelsior. Had all his witnesses testified definitely that Rafter’s excelsior was torn, such testimony still could not outweigh the mute testimony of the physical exhibits referred to above. BUT all of Defendant’s witnesses did not so testify.

For the convenience of this Court, Plaintiff will now discuss the witnesses named by Defendant in his brief, in the order in which he has placed them, so that by



reference to this brief, the same corresponding witness may be found in Defendant's brief in the same relative position.

Before considering the witness' testimony, we call the Court's attention to Exhibit 2. EXHIBIT 2 IS A SAMPLE OF EXCELSIOR PRODUCED BY THE TEARING METHOD LESS THAN THIRTY DAYS BEFORE THE TRIAL. This exhibit is referred to in the witness' testimony and in each instance the witness was asked if said exhibit 2 was like the excelsior he saw in 1924.

In many Supreme Court cases, including the Barbed Wire Patent, this practice of identifying models and reproduced copies of original articles has been declared unsound, and such evidence rejected. See *Parker v. Stebler* (C. C. A. 9) 177 F. 217. (Page 89, our opening brief)

In his brief, Defendant contends that the following witnesses testified that the excelsior from Rafter's machine was torn. Plaintiff denies that the testimony is to that effect. We claim the testimony is entirely negative, ie., that the witnesses never observed any difference between the early excelsior and exhibit 2. The witnesses do not undertake to testify that the excelsior, Exhibit 2, and that produced by Rafter, is the same.

Most of the following remarks of witnesses are taken verbatim out of the record.

**G. H. THOMPSON.**

When asked if Exhibit 2 was like the excelsior he first saw in 1924, the witness replied:

R. 297. "Well, I would say that this is—you can readily see that I am not a technician on this. I would say that this is very similar to the kind of excelsior we have been using right along from the beginning.

R. 298. So far as I know all of this excelsior was about the same. I have never noticed any difference at all that I could tell you about. I didn't do that packing work myself.

R. 298. I couldn't tell you whether it is cut or torn."

**THOMAS E. HENDERSON.**

This witness is the one who operated a Rafter machine in California, and who testified that the Rafter machine had *two coil springs one on each end of the upper shaft to take up the vibration.*

Rafter denied that any such a machine was ever manufactured, and obviously none was, because such a machine could not function.

It is obvious that if this witness could not accurately observe the presence of only one spring on an exposed portion of the machine, he could not accurately observe whether excelsior was torn or cut. This witness' testimony with reference to the edge of the excelsior is negative.

R. 299. "The appearance of this early excelsior as near as I can tell was just like this here, Defendant's Exhibit 2."

Mr. Henderson at the time of trial was over seventy years of age.

## **B. T. RAND.**

This man was a neighbor to Rafter, engaged in the real estate business. He testified on Record 304:

"I am not a mechanic—don't know a thing in the world about machinery. Exhibit 2 is similar to the excelsior I saw in 1923. I would imagine that was about the same excelsior."

## **R. M. BENSON.**

Mr. Benson was purchasing agent for a company that used excelsior. Mr. Benson never did the packing, and never handled the excelsior. He was testifying from memory about a product which he had only casually observed ten years before. His testimony (R. 307 and 308) is as follows:

"I never noticed any difference in the texture of the outer edges between the first excelsior bought and that recently purchased.

I would have no occasion to notice. I did not handle it.

I never paid any attention to the physical condition of the excelsior."

**WILLIAM D. RAINWATER.**

This man testified as follows:

R. 315. "I do not remember in detail the nature of the paper excelsior I first used. It has been so long ago. I never paid much attention to it. In fact, I didn't do any of the packing myself in the early days. I couldn't say whether there is any difference in the first excelsior I used and the present day excelsior.

R. 316. I have never noticed any difference."

**CHARLES W. PALMER.**

This witness was a purchasing agent for a grocery firm. Under the leading questions of the Defendant, he indicated that Exhibit 2 was similar to the excelsior first purchased by his company, but on cross examination (R. 318) he testified:

"I simply saw that it was a clean product. It made no difference to us whether it was rough or not.

Well, I will tell you, to me it is paper excelsior. I will have to answer that question exactly the same as I did, in an honest way, that as far as the edges of the paper are concerned, as far as the width of the strips are concerned, it was all paper excelsior to me."

**CLAUDE E. RAFTER.**

This witness gave the interview for the Times news-



paper article of March, 1925, in which the process of manufacturing paper excelsior employed by the alleged anticipating device of Claude C. Rafter was clearly described at that time as a *cutting device*. Nowhere in that article is the word "tearing" used. This witness testified that he read the newspaper article afterwards, and that it correctly set forth what he had told the reporter. That the discs of the cutting machine were knives that cut in a similar fashion as the blades of shears. Enlarged prints of the pictures taken of this excelsior are in evidence, and the Court will observe that the character of the excelsior shown by those pictures is cut.

The testimony of this witness is obvious, when he testified

R. 305. "The more paper you put through the machine the more the machine would tear it instead of cut it, really."

The reason for this witness changing his opinion about his Father's excelsior machine from that expressed in the newspaper article in 1925, to that testified to in 1933, is very obvious. His father had adopted the Antonsen discovery of tearing paper excelsior instead of cutting it. This son of Rafter has reformed his ideas of his Father's first machines by now saying that the more paper put through the machine, the more it would tear instead of cut. The history of this witness, and the comparison of his statements made of record in 1925, with his present day testimony needs no further comment.

**LEONARD E. SIMPSON.**

This witness clearly testified that the capacity of the Rafter machine was limited to four to six pages. The limited capacity of a cutting machine was the thing that clearly impressed itself upon the minds of all of its operators, and is uniformly testified to by them. (R. 309) The operators of the early machines were so harassed by the machines clogging, stopping, jamming and the subsequent work necessary to get the machine into operation again. It was such an experience as to make it impossible for those operators to forget the incident.

It must be remembered that Antonsen in his patent application in 1926, clearly set forth the limited capacity of the cutting machines and the increased capacity of his invention.

This witness on cross examination (R. 310) verifies the facts of Antonsen's invention, and the increased capacity of the tearing machine, and the elimination of the clogging and jamming trouble.

**C. C. RAFTER.**

The Court in his opinion said that this witness was discredited. Counsel for appellee in his argument before this Court, admitted that Rafter was thoroughly discredited. However, we desire to point out again the testimony of this witness that the discs of his machine were in facial contact. This testimony is on R. 284, as follows:



“Q. What was the mechanical function of that spring?

A. Well, it was to keep the upper roll against the lower roll in contact, so that it would draw the paper in.”

That testimony is an unconscious admission by Rafter that his device was a cutting machine with the discs in facial contact, because elsewhere Rafter testified that his device was *adjusted* so that there was a constant separation between the discs. This admission corroborates Rafter's file wrapper, Ex. 28.

### C. A. WHEELER.

This witness testified that the day before testifying, he had purposely examined Defendant's machine to see if the discs were in contact or not, and testified positively that none of the discs were in contact. (R. 198)

Obviously this witness was wrong, because the Defendant, (R. 203) Defendant's expert, (R. 218-219) Plaintiff's experts, (R. 96-150) and admission of counsel for appellee all show that two or more of the sets of discs on Defendant's machine were in contact, that the same acted as a set collar, taking up the entire force of the spring, and acting as a means for adjusting the spaced relationship between all the remaining discs, keeping them out of contact and by that simple expedient producing torn paper excelsior, infringing Plaintiff's patent. (R. 137)

This witness introduced excelsior claimed to have

been manufactured in the winter of 1924. Dated strips were taken from that excelsior showing that it had been cut from newspapers not published until sometime after June 13, 1925. (R. 238) Since Wheeler was wrong in stating the time of manufacturing that excelsior, he could likewise have been wrong in other matters, and in fact was wrong about the adjustment of the discs of Defendant's machine at the time of trial. This witness Henderson, was seventy years of age. He was an interested witness because he had not yet been fully paid by the Defendant for the purchase price of the Defendant's machine. (R. 203)

COUNSEL FOR APPELLEE ON ARGUMENT ADMITTED THAT WHEELER AND THE DEFENDANT HAD BEEN FOOLING AROUND WITH THE DEFENDANT'S MACHINE AND THAT SOME CHANGES HAD BEEN MADE. This express admission by counsel for defendant verifies Plaintiff's contention that Defendant's machine has been changed, and now employs the patented method of tearing paper excelsior, as distinguished from the cutting method originally employed by it. As previously pointed out this has been established by the clear description of Rafter's device in his patent application, Ex. 28; in Rafter's oral testimony of the discs in contact; in the newspaper article of March, 1925; the photographs of excelsior appearing in that newspaper article, in the corroborating testimony of witness Foster that Rafter's machine was a cutting machine, with the discs in contact, (R. 325) in the corroborating testimony of Plain-

tiff's expert Rockwell, who examined one of Rafter's original device, in the testimony of witness Mrs. Wright, who testified that Rafter's original device, operated by her made cut excelsior (R. 332), and in Plaintiff's testimony to the same effect. (R. 81)

### **E. L. FOSTER.**

He testified in the last paragraph of his cross examination, on R. 323.

“When he bought the machine (from Rafter) the discs were sharp, the discs on the upper and lower roll were touching, held in contact by a spring. In my opinion the machine was essentially a cutting machine.”

### **KENNETH W. HOLMAN.**

The only thing this witness could recall about 1925 was that he was fifteen years old, and that the excelsior was rough edged. He could not remember which high school he was attending, whether he saw the excelsior in the spring, fall or winter of 1925, nor could he remember the year he began work for the establishment that purchased the excelsior he first saw. (R. 180)

### **L. V. SCOTT.**

This witness' casual examination of the excelsior ten years before his testimony is explained on R. 191, when he said:

“I wanted to see if paper excelsior was practical, whether it was clean enough to meet requirements.”

He had no further interest, and could hardly be expected to recall ten years later the condition of the edges of the paper strips that he had so casually examined.

### C. C. HEDRICK.

This witness can testify to nothing prior to March, 1929, as that is when he first came in contact with excelsior, and excelsior machines. (R. 200)

The vice of appellee quoting only a portion of testimony of a witness is exemplified on page 14 of his brief, where he referred to the witness Vernon Faxon. Counsel quoted from his testimony:

“He found some edges with torn or rough appearance.” (R. 182.)

We direct the Court’s attention to the full testimony of that witness appearing on R. 182, and continued to 183, as follows:

“Q. What did you find?

“A. I found *some of them* with torn or rough appearance, and some of the appeared to be smooth or machine cut, although you can’t state that change so definitely as you can the other.”

This witness was asked to mark the strands of excelsior with rough edges, and he could pick out only a few from the countless thousands of strips appearing in the photo-



graphs. Counsel for appellee seeks to explain away that damaging fact by saying the picture was out of exact focus. *If the picture was out of exact focus, that fact would make straight edged excelsior appear to be ragged edged, but it could never make ragged edged excelsior appear to be machine cut.*

### ***Discs Melting Down***

On page 17 of his brief, defendant urges the absurd contention that Rafter's machines could not have had the cutting discs in facial contact, because the discs would have heated, melted down and not lasted a day.

He uses this language: "even a layman knows what happens when metals such as were in the discs, run in surface contact at the rate of speed the discs were operating."

Yet, when asked by this Court during oral argument, what rate of speed the discs were operating at, he replied he didn't know!

But the most astounding fact in the entire record, is that defendant's machine for some years has operated with two sets of discs in facial contact. The entire strength of the spring present on the upper shaft, which spring was designed to bring all 90 discs into facial contact, is exerted on just *those two discs*. This fact is admitted by defendant (R. 203) and even by defendant's expert (R. 219-219). Altho that latter gentleman testified that metal discs in contact could not last a day. (R. 233 and 224)

The rolling motion of the tips of these discs coming together for a short space and the air cooling of the discs as they complete circling around, together with the lack of any degree of rubbing between the discs is fully explained by Expert Rockwell. (R. 104)

### ***Trouble In Operating Rafter's Machine***

On page 28 of defendant's brief, the Court's inspection is invited to the testimony of certain witnesses. Defendant claims Rafter's machine did not cause the trouble plaintiff would have the Court believe.

Please compare the following with the cited references of defendant.

"When too much paper was fed to the machine it stopped and chewed up the paper." Wright R. 333.

"I ran two or three sheets through and more than many more. It was a very disagreeable thing when it got stuck." Wright R. 335.

"When I saw the Rafter machine in Seattle it would take and run one up to about six or seven sheets of paper at a time. If you would run more through it would kinda chock and stop sometimes. You would roll the fly wheel back, roll the paper back. If there was any chocked in there, take a hook or whatever we used for the purpose, hold in between the discs and get the paper out." Henderson (R. 300.)

"I put additional longitudinal strips on the machine for the purpose of forming rests at the top



and bottom to form a fulcrum for the tool I used to clean the paper from between the discs when they became filled.” Wheeler (R. 194.)

“I had plenty of trouble with the machine. If I fed more than 4 or 5 sheets at a time, about every 15 minutes the thing would clog up, part of the paper would stick in the knives. Sometimes when the paper stuck it would pull the pulley off.” Simpson (309.)

Plaintiff maintains, that no one can read that testimony and not be convinced that Rafter’s devices gave great trouble due to the clogging and jaming when the machine was *overcrowded*. This was due to the limited capacity of cutting machines. (R. 77) The increased capacity of the tearing method was 40 sheets or 80 pages instead of 60 as misquoted by defendant’s brief. (See, R. 77)

*Overcrowding* implies feeding a larger number of sheets to the machine than it is designed to accommodate. Overcrowding is abnormal and excessive feeding of paper.

Although defendant in his brief and his oral argument refuses to admit that the Rafter machine manufactures torn excelsior only when overcrowded, if at all, yet the Trial Court in the seclusion of his chamber, after having signed the Findings of Fact, and while reflecting on the evidence of this case, reduced his oral decision to writing. That is the written opinion on Record pages 29 to 37.

The Trial Court said: R. 33

“The machine (Rafter’s) would *cut* paper with *straight edges* only if the sheets were fed a few at a time and no great speed was attained.”

“The Foster machine, built by Rafter, was operated by hand power by Antonsen for his attorney to illustrate the idea that Rafter machines only cut paper. But if he had so operated it as to bring the spring into play by *overcrowding*, the result would have been different.”

The Trial Court said; R. 35

“Antonsen performed two services. He stabilized the discs in the position which they attained in the Rafter machine when *overcrowded* and operated at high speed.”

In clear language the Court sets out that Rafter’s device produced a different kind of excelsior when it was *overcrowded*. If the device was normally fed, it produced cut excelsior.

We observe, that if Rafter’s machine incidently and accidentally made torn paper excelsior when the overcrowding was sufficient to change the function of the machine, then such abnormal, periodic and uncertain production *could not constitute prior use*.

The clear rule of law is that prior use must be understood and appreciated, practiced and persisted in so as to become an established fact, accessible to the public and contributing definitely to the sum of human knowl-

edge—not something incidental, indefinite and fugitive, which is now hunted up and brought forward simply for the purpose of defeating the patent. See cases cited in our opening brief, pages 78 to 87.

Defendant is in error in stating plaintiff built his machine stronger and sturdier. That is a creature of his imagination, for the record does not contain an iota of evidence of that kind. The facts are just the contrary. The record shows that plaintiff took one of Rafter's machines and by adjusting its parts made it perform a new function in a new way. This was the same element of inventive genius as recorded in the case of *Eibel v. Paper Stock Co.* 261U.S.45.

### ***Defendant's Claims About Novelty***

We do not understand defendant's purpose in inserting on pages 29 and 30 of his brief the question of novelty in the form there presented. This was not included in the pleadings. Defendant did discuss it in his brief in the Court below, but the Trial Court ignored the matter entirely. At least, he made no mention of it.

As we view counsel's argument, he contends that plaintiff was not entitled to a patent on the tearing method because that method was contained in one of the claims rejected by the Patent Office. Defendant is in error.

In Exhibit 13, Antonsen's File Wrapper, on page 11, will be found claim 9, which was allowed verbatim as claim 7, the one in suit. There was not one single

change in the claim as filed and as allowed.

Original claim 8 was rejected altho identical with original claim 9, except claim 8, in the first step reads "shredding sheets of paper stock into strips", while the first step in claim 9 reads "tearing sheets of paper stock into narrow strips." According to all dictionaries "shredding" means cutting or tearing into shreds. It is obvious, therefore, that original claim 8 was rejected for the reason that the language thereof might be so construed as disclosing a method for cutting paper into narrow strips, and this method was old.

### *Infringement*

Counsel's claim that defendant's machine does not infringe plaintiff's patent is not entitled to serious consideration (Defendant's Brief, page 31) The law of equivalents is well stated in *Pedersen v. Dundon* 220 F. 309 C. C. A. 9

"The two devices so used by him are clearly the mechanical equivalent of the appellee's hinges. Neither the joinder of two elements of a patented combination into one integral part, accomplishing the purpose of both, nor the separation of one integral part into two, which together accomplish substantially what was done by the single element, will avoid a charge of infringement."

Applying that rule as announced by this Circuit to the facts in this case, there can be no doubt remaining that the defendant's machine infringes plaintiff's patent.



In his testimony Mr. McDougall clearly pointed out that claims 1 and 2 read upon the defendant's machine, (R. 153-8) that the defendant's machine has all of the elements described in claims 1 and 2 of plaintiff's patent. This machine functions the same and produces the same results as the machine constructed according to the specifications of the Antonsen patent. Likewise there can be no question but that the paper produced by the defendant's machine is made according to the Antonsen method as covered by claim 7 of his patent.

### *Conclusion*

Plaintiff's patent was duly and regularly issued. It has been decreed valid in other cases. It has met with commercial success. Users of the patent are paying royalty for the privilege thereof. The utility of the tearing method and its advantages over the old art of cutting excelsior is not in dispute. The machine claims and method claim are entitled to be liberally construed as to validity and infringement. Defendant has failed to establish anticipation by that high degree of proof required by law. (See citations on pages 70 to 78, our opening brief).

The decree should be reversed.

Respectfully submitted,

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